

### **REMARKS/ARGUMENTS**

Entry of the foregoing amendments to the claims, withdrawal of the Final Rejection, reconsideration and allowance of the foregoing claims are respectfully requested.

#### **Status of Claims**

After the above amendments, the following claims are pending and finally rejected: Claims 1, 3-23, 25-29, 31-34, 80-100, 102, and 105-106.

The Abstract has been amended to more fully set out the subject of the disclosure of the present application. It is believed that the new abstract is in full compliance with the Rules and therefore the objection to the specification has been obviated and should be withdrawn.

The examiner has rejected all claims under 35 U.S.C. §103(a) as unpatentable based on U. S. Patent No. 5,617,857, Chader et al., hereafter "Chader." This rejection as it applies to the amended claims is respectfully traversed.

All claims set out that the instrument transmits information in response to a signal from the surgery system when the instrument is placed within a field of detection. Unlike the system and instruments described in Chader, where the user must physically connect the instrument to the system for the system to recognize and be able to use the instrument, in the present invention, the instrument merely need be placed within the field of detection of the system. This improvement facilitates the use of multiple instruments as might be needed during various surgical procedures without requiring the user to perform any additional steps other than to pick up the instrument and begin to use the instrument in a normal fashion. Chader only discloses and teaches the recognition of the instrument when it has been physically connected to the system. There is no disclosure in Chader of this automatic, in the sense that the user need perform no added steps, recognition of the instrument. It is believed that the invention as set out in the instant claims would not have been obvious to one of skill in the art at the time the present invention was made. There were a number of "wireless" systems known at the time of the Chader invention, including passive optical, acoustic systems, and magnetic systems. However, even with this knowledge, Chader still only described a wired system that depended on a physical connection of the instrument to the system to have the system recognize the instrument for use. It

is contended that a person of ordinary skill at the time the present invention was made would not have considered a wireless instrument useable with a surgical system as claimed as an obvious variant of Chader. Therefore this rejection should be withdrawn.

The examiner has also rejected all claims under 35 U.S.C. §103(a) as unpatentable based on Chader taken with U. S. Patent No. 6,453,190, Acker et al., hereafter "Acker." This rejection as it applies to the claims now presented for examination is respectfully traversed.

As noted previously, Acker does not contain any of recognizing an instrument when the instrument is placed in a field of detection. While Acker does describe a wireless alternative to a wired system, there is no disclosure or suggestion of the recognition required by all claims now pending. Therefore, this rejection is no longer warranted and should be withdrawn.

Although applicants believe that the present claims are allowable, applicants are concurrently filing a Notice of Appeal with this amendment. If the examiner determines that the above amendments do not place the application in condition for allowance, the examiner is requested to enter the above amendments for the purpose of the appeal, as these amendments simplify the issues for appeal.

**Deposit Account Authorization**

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903. A copy of this Transmittal is enclosed.

Respectfully submitted,

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By 

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